REMARKS

Prior to entering the attached amendment, claims 20-23 and 38-56 were pending. In the attached amendment, Applicant amends claim 20 and 38. Applicant submits that no new matter has been introduced. Applicant requests reconsideration and allowance of claims 20-23 and 38-56 in view of the attached amendment and the following remarks.

The Examiner rejected claims 20, 21, and 38 as being anticipated by, or in the alternative, as obvious over U.S. Patent No. 5,163,433 issued to Kagawa *et al.*, and claims 22 and 23 as obvious over Kagawa *et al.* Applicant traverses this rejection.

Independent claim 20, as amended, recites "inserting into said cavity a device for cutting and detaching said tissue, said device being driven by coupling to a motor" (emphasis added). Kagawa *et al.* fail to describe or suggest at least the claimed insertion of a device driven by coupling to a motor. The Examiner states on page 3 of the Office Action dated December 22, 2003, that "a motor is a device that converts any form of energy into mechanical energy," and that "KAWAGA['s] device is a device that receives electrical energy via piezoelectric elements to convert into mechanical energy." Thus, rather than being a device driven by coupling to a motor, according to the Examiner, Kawaga's device itself is a motor.

Furthermore, Applicant traverses the Examiner's characterization of the regulation of pressure in Kagawa *et al.*.

Therefore, for at least the reasons discussed above, claims 20 and its dependent claims are patentable over Kagawa *et al.*.

Independent claim 38 recites "discharging fluid with detached tissue along a first path, and discharging substantially only fluid along a second path completely separate from said first path" (emphasis added). Applicant respectfully submits that Kawaga *et al.* do not teach a first path which is completely separate from a second path, as now claimed, but rather, Kawaga *et al.* disclose paths 26 and 21 which are connected at suction tube 16. *See* e.g. Kawaga *et al.* at Fig. 1. As a result of this connection, paths 21 and 26 are not completely separate. Therefore, for at least this reason, claim 38 is patentable over Kagawa *et al.*.

The Examiner has rejected claims 39-42, 44-52, and 54-56 as being anticipated by U.S. Patent No. 5,449,356 issued to Walbrink *et al.*, and claims 43 and 53 as obvious over Walbrink *et al.*. Applicant traverses this rejection.

Independent claim 39 recites "inserting a cutter into a lumen of an endoscope through a valve of the endoscope," and independent claim 49 recites "inserting a cutter into a distensible organ through a shut-off valve of an endoscope" (emphasis added).

Walbrink *et al.* fail to describe or suggest inserting a cutter through an endoscope. The Examiner's rejection equates probe 20 of Walbrink *et al.* to the claimed endoscope. However, probe 20 is not an endoscope. Rather, Walbrink *et al.* describe an endoscope in the form of a wand-like device 38 attached to a video camera and a light source for viewing interior organs so that a surgeon can manipulate a separate surgical probe 20. *See* e.g., Walbrink et *al.* at column 5, lines 60-68. As shown in Figure 1 of Walbrink *et al.*, the probe 20 is not inserted through the wand-like device 38, but rather is inserted directly into abdominal wall 26.

Therefore, for at least the reasons discussed above, claims 39 and 49 and their dependent claims are patentable over Walbrink *et al.*.

All claims are in condition for allowance, which action is requested.

Enclosed for consideration by the Examiner is an Information Disclosure Statement, a corresponding PTO FORM-1449, and a check for $180.00. Please charge any additional fees or credits to Attorney's Deposit Account No. 06-1050.

Respectfully submitted,

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